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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,196	02/15/2002	Eugene L. Lew	214232US8	7077
22850	7590	06/13/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SORRELL, ERON J	
			ART UNIT	PAPER NUMBER
			2182	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,196

Applicant(s)

LEW ET AL.

Examiner

Eron J. Sorrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/17/02</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 5/17/02 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the listing of the pending US applications fails to identify the inventor(s). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Specification

2. Please update the status of the identified co-pending or related applications with serial numbers and filing dates, or U.S. Patent Numbers if they have so matured.

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Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7,15, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claims 7,15, and 24, the phrase "an another transfer utility" renders the claim(s) indefinite because the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). It is unclear to the Examiner what other transfer utilities are included or excluded by the phrase "another transfer utility."

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 19-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Claims 19-26 are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 29, line paragraph 74, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., compact disks, hard disks, floppy disks, tape, magneto-optical disks, etc.) and intangible embodiments (e.g., carrier waves, acoustic waves, and light waves). As such, the claim is not limited to statutory subject matter and is therefore non-statutory. It is noted that at page 29 paragraph 74, the applicant is using the term "computer readable medium" to refer memory and at claim 19, applicant is using the term computer storage medium to refer to a memory, thus "computer readable medium" and "computer storage medium" are being used interchangeably.

8. In the interest of compact prosecution, claims 19-26 will be examined as if they were limited to statutory subject matter for the purpose of applying prior art rejections.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple

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assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No.

010/075,200. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application comprises limitations reciting, "receiving a provisioning event requesting a minimum quality of service for a modem," and "transmitting the modem configuration file to the modem such that the modem will implement the minimum quality of service." Application 10/075,200 comprises limitations reciting, "receiving a provisioning event requesting a maximum data rate for a modem," and "transmitting the modem configuration file to the modem such that the modem will implement the maximum data rate." The term quality of service as used in the instant application refers to the maximum data rate. All other limitations are identical.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1,6-10,14-19, and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Cloonan et al. (US 2002/0065907 hereinafter "Cloonan").

13. Referring to claim method claim 1, system claims 10 and 18, and computer product claim 19, Cloonan teaches a method, and system comprising:

receiving a provisioning event requesting a minimum quality of service for a modem (see paragraph 25 on page 2, note the request is provided through a web site);

generating a modem configuration file for the modem to implement the minimum quality of service based on the provisioning event (see paragraph 45 of page 4);

rebooting the modem (see paragraph 96 on page 9); and

transmitting the modem configuration file to the modem such that the modem will implement the minimum quality of service (see paragraph 25 on page 2).

14. Referring to method claim 6, system claim 14, and computer program product claim 23, Cloonan teaches the rebooting step comprises rebooting the modem using dynamic host configuration protocol commands (see paragraph 96 on page 9).

15. Referring to method claim 7, system claim 15, and computer program product claim 24, Cloonan teaches the transmitting step comprises transmitting the modem configuration file using at least one of a trivial file transfer protocol, a file transfer protocol, and another transfer utility (see paragraph 81 on page 8, Cloonan teaches at least the trivial file transfer protocol).

16. Referring to method claim 8, system claim 16, and computer program product claim 25, Cloonan teaches the minimum quality of service comprises at least one of a committed level of

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bandwidth, a network availability, an error performance, a metric of lost calls or transmissions due to network congestion, a connection setup time, and a speed of fault detection or correction (see paragraph 4 on page 1, Cloonan teaches at least a committed level of bandwidth).

17. Referring to method claim 9, system claim 17, and computer program product claim 26, Cloonan teaches the receiving step comprises receiving the provisioning event through at least one of a customer service representative, an end-user of the modem, and a non-human triggering event through at least one of a hardware device or software mechanism (see paragraph 25 on page 2, Cloonan teaches at least the end-user of the modem).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. Claims 2,3,11, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloonan in view of Belostotsky et al. (US 2002/0052205 hereinafter "Belostotsky").

20. Referring to method claims 2 and 3, system claim 11, and computer program product claim 20, Cloonan fails to teach the limitations of:

a provisioning event categorization mechanism configured to categorize a received provisioning event as one of a non-time dependent provisioning event, a start time provisioning event, and a stop time provisioning event;

a start time provisioning event processing mechanism configured to wait for a start time if the received provisioning event is a start time provisioning event prior to generating the modem configuration file, rebooting the modem, and transmitting the modem configuration file to the modem; and

a stop time provisioning event processing mechanism configured to wait for a stop time if the provisioning event is a stop time provisioning event prior to generating another modem configuration file for the modem when the stop time has been reached to implement a previous minimum quality of service based on a quality of service of the modem prior to receiving the provisioning event, reboot the modem, and transmit the another

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modem configuration file to the modem such that the modem will implement the previous minimum quality of service.

Belostotsky teaches, in an analogous system, a provisioning event categorization mechanism, a start time provisioning event mechanism, and a stop time provisioning event mechanism as described above (see paragraphs 65-68 on page 4 and figure 4).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Cloonan with the above teachings of Belostotsky. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to schedule communications based on specific requirements of each service being utilized by the user as suggested by Belostotsky (see paragraph 15 on page 1).

21. Claims 4,12, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloonan in view of Drews (U.S. Patent No. 6,539,480).

22. Referring to method claim 4, system claim 12, and computer product claim 21, Cloonan fails to teach the configuration file comprises a digitally signed file.

Drews teaches, in an analogous system, configuration files comprising a digitally signed file (see paragraph bridging columns 3 and 4).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Cloonan with the above teachings of Drews. One of ordinary skill in the art would have been motivated to make such modification in order to ensure the updated configuration files are coming from a trusted source as suggested by Drews (see lines 38-46 of column 1).

23. Claims 5,13, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloonan in view of White (US 2001/0032311).

24. Referring to method claim 5, system claim 13, and computer product claim 22, Cloonan fails to teach the configuration file comprises an MD5 file.

White teaches, in an analogous method and system, a configuration file comprising an MD5 file (see paragraph 55 on page 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the

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system and method of Cloonan with the above teachings of White. One of ordinary skill in the art would have been motivated to make such modification in order to securely transfer configuration files over the Internet and verify the correct reception of the file using an efficient hashing algorithm as suggested by White (see paragraph 5 on page 1).

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following U.S. Patents have been cited to further show the state of the art as it pertains to modem configuration:

U.S. Patent No. 6,636,485 to Fijolek et al. teaches a method and system for providing quality of service in a data over cable network;

U.S. Patent No. 6,785,556 to Souissi teaches a method and apparatus for downloading configuration information to a modem.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J. Sorrell whose telephone number is 571 272-4160. The examiner can normally be reached on Monday-Friday 9:00AM - 5:30PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can

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be reached on 571 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EJS
June 9, 2005


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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100